

Appl. No. 09/284,862
Amendment dated January 6, 2004
Reply to Office Action of October 6, 2003

REMARKS

Claims 1, 5, 6, 10, 12, and 15-17 are pending in this application. Previously, claims 2-4, 7-9, 11 and 13-14 have been canceled without prejudice or disclaimer. For purposes of expedition, claims 1, 5, 6, 10, 12, and 15-17 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections in accordance with current Office policy, to further and alternatively define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

Claims 1, 5, 6, 10, 12, and 15-17 have been rejected under 35 U.S.C. §103 as being unpatentable over Kanamori, U.S. Patent No. 5,232,081, in view of Ishibashi, U.S. Patent No. 5,087,423 for reasons stated on pages 2-3 of the Office Action (Paper No. 26). In support of this rejection, the Examiner asserts that Kanamori '081 discloses a modular analyzer system including all claimed features, except for "the use of a specimen rack conveying part for reciprocally conveying the specimen rack to at least two analyzers" which is allegedly disclosed on column 3, line 66 extending to column 4, line 3, and column 8, line 43 extending to column 9, line 36 of Ishibashi '423. This rejection is respectfully traversed, however. Applicants respectfully submit that features of Applicants' base claims 1 and 6 are not disclosed or suggested by Kanamori '081 or Ishibashi '423, whether taken individually or in combination with any other references of record. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection for the following reasons.

As a preliminary matter, base claims 1 and 6 have been amended, for purposes of expedition, to incorporate therein the specimen rack conveying part

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having an ongoing straight path and an incoming straight path which are entirely straight over their allover lengths. Specifically, base claims 1 and 6 define, *inter alia*, the ongoing straight path and the incoming straight path which are entirely straight over their allover lengths, and which are extended in rear of all component modules (parts), that is, the specimen rack introducing part, the plurality of analyzing parts, the reexamining buffer and the specimen storage part as described on page 24, lines 10-15 of Applicants' specification.

These modules (parts) having an equal height and an equal dept can form an apparently integral and continuous biochemical analyzer having a substantially flat front panel and a substantially flat top panel after they are arranged along the straight paths. Moreover, since these modules (parts) are independent from the ongoing straight path and the incoming straight path, these modules (parts) can be separated, independent from one another, by being pulled forward from the ongoing straight path and the incoming straight path. With this arrangement, the installation of the modules (parts) to the ongoing straight path and the incoming straight path can be facilitated. As a result, if any single module (part) fails, the individual module (part) can be removed for replacement with new one without stopping conveyance of the specimen racks on the ongoing straight path and the incoming straight path. Therefore, one specimen rack can pass over another specimen rack through the ongoing straight path and the incoming straight path, while the later module is introduced into one of the modules for processing the same.

In contrast to Applicants' base claims 1 and 6, Kanamori '081 discloses a sampler, as shown in FIG. 1, for transporting sample racks to analyzers, such as blood analyzers and smeared sample generators, for sample analysis. As shown in

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FIG. 2 and FIG. 3, rack start/stop units 16A-16E are used to receive sample racks 18 from outside the equipment and to send the sample racks 18 to the outside of the equipment. However, these rack start/stock units 16 have different configurations and transport the sample racks 18 in different directions, zigzagging among different modules.

Kanamori '081 does **not** disclose any specimen rack conveying part having the above-mentioned ongoing straight path and incoming straight path which are entirely straight over their allover lengths, and which are laid independent from the modules in rear of the latter. As a result, the specimen rack cannot bypass any of the modules while being transported on the segment paths. Thus, one specimen rack cannot pass over another specimen rack even though the latter rack is processed in one of the modules.

As a secondary reference, Ishibashi '423 does **not** remedy the noted deficiencies of Kanamori '081 in order to arrive at Applicants' base claims 1 and 6. This is because Ishibashi '423 simply discloses an automatic analyzing apparatus, as shown in FIG. 5, in which different analyzing modules 71, 72, 73 are used to receive a sample cup, via different analyzing routes 78, 79A, 80, which are zigzagging through respective distributors 77a, 77b, and 83. Ishibashi '423 does **not** disclose any specimen rack conveying part having the above-mentioned ongoing straight path and incoming straight path which are entirely straight over their allover lengths, and which are laid independent from the modules in rear of the latter as expressly defined in Applicants' base claims 1 and 6.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must show that the prior art reference (or references when combined)

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must teach or suggest all the claim limitations, and that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings, provided with a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. In other words, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USQP 494, 496 (CCPA 1970).

More importantly, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." ACS Hospital System, Inc v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner must point to something in the prior art that suggests in some way a modification of a particular reference or a combination of references in order to arrive at Applicants' claimed invention. Absent such a showing, the Examiner has improperly used Applicants' disclosure as an instruction book on how to reconstruct to the prior art to arrive at Applicants' claimed invention. Any deficiencies in the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". See In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002).

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In the present situation, Kanamori '081 and Ishibashi '423 fail to disclose and suggest key features of Applicants' claims 1 and 6. Therefore, Applicants respectfully request that the rejection of Applicants' base claims 1 and 6 and their respective dependents be withdrawn.

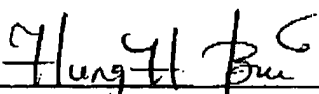
In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC area office at (703) 312-6600.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage of fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, No. 01-2135 (Application No. 500.37156CX1), and please credit any excess fees to said deposit account.

Respectfully submitted,

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